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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,375	10/25/2001	Todd Fischer	10012680-1	2870

7590 01/11/2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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Fort Collins, CO 80527-2400

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,375

Applicant(s)

FISCHER, TODD

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-13 and 15-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,2,4-13 and 15-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Status of Claims

1. Claims 1, 2, 4-13, and 15-19 have been examined.

Response to Arguments

2. Applicant claims a printing device comprising a remote print system.

Applicant is of the opinion that the Examiner's rejection equates a computer with a printer when this is clearly not the case, especially when the Examiner relies on Choudhury et al. to teach printer exchanging data with a server using cryptographic protocols ('074, column 4, lines 1-5 and 32-42). Applicant's "provide", "receive", "decrypt" and "enable" steps are well known to those of ordinary skill in cryptography (e.g. public-key cryptography if the encryption are different, or secret key cryptography if the encryption and decryption key are one in the same). Maldy discloses public/private key cryptography where a receiver generates a key pair. A first (public) key is sent to a sender for encrypting a message intended for the receiver. The sender encrypts the message using the first key then sends the encrypted message to the receiver who decrypts it using the second (private or secret) key ('406, column 1, lines 11-47). Maldy discloses cryptography for securing messages between two electronic devices connected over a network (e.g. electronic or digital information transfer, e-mail- '406, column

1, lines 10-15). Maldy does not disclose the type of devices engaged in the communication exchange. Choudhury et al. clearly teach securing communications between two devices connected over a network where one of the devices is a printer ('074, column/line 3/66-4/12). Therefore, an obvious modification of the public key crypto system disclosed by Maldy is to a printer for securely receiving documents ('074, column 4, lines 32-35). Regarding the generation and provision of keys, it has been held that that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result (*In re Venner*, 120 USPQ 192, 195; *In re Rundell*, 18 CCPA 1290, 48 F.2d 958, 9 USPQ 220). Hence, an obvious modification of Maldy, to one of ordinary skill, if not inherent, or explicitly taught, would be to generate public/private key pairs using the communicating computational devices. In light of Choudhury et al. such a computational device would be the printer as it shares cryptographic keys with a remote server ('074, column 4, lines 1-5) and such a printer is well within the skill of an ordinary artisan ('074, column 4, lines 1-5 and 32-42). Once the keys are generated, the user in the Maldy teaching sends a public key to a second device that encrypts data using the public key and transmits the encrypted data back to the user. As the user "uses" the generated public key, it was necessarily "provided".

The following assertion of facts has gone unchallenged and is therefore considered admitted prior art:

- displaying of public keys

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-13, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maldy, U.S. Patent No. 5,956,406 in view of Choudhury et al., U.S. Patent No. 5,509,074.

As per claims 1, 2, 4-13, and 15-19, Maldy discloses a method and system for enabling secure communications between two users, devices and/or systems. Specifically, Maldy discloses public/private key cryptography where a receiver generates a key pair. A first (public) key is sent to a sender for encrypting a message intended for the receiver. The sender encrypts the message using the first key then sends the encrypted message to the receiver who decrypts it using the second (private or secret) key (column 1, lines 11-47). Regarding the displaying of the public key, the Examiner takes Official Notice that the displaying of public keys is old and well-known. Maldy, however, does

not specifically recite using cryptography to secure communications between a printer and server (e.g. data encryption/retrieval system). Therefore, in view of the clear teachings of Maldy and what it would have rendered obvious to one of ordinary skill, the patentability of Applicant's claims then rests on whether there is a prior art teaching that explicitly recites or at least suggests a need for the confidential communication of data between a remote print system (i.e. printer) and a data encryption/retrieval system, such as a server. Choudhury et al. teach a method and system for sending a message (i.e. content) from a server to a printer (figures 1 and 2). More specifically, Choudhury et al. teach a user at a request system communicating with a data encryption/retrieval system (figure 4) for requesting the message be sent with the intent of the user printing the message (column/line 3/66-4/21), where the message is encrypted using a cryptographic protocol (column 4, lines 21-35). Regarding portability, it has been held that an obvious modification to the request system (figure 4) of Choudhury et al. would have been to make it portable (*In re Lindberg*, 194 F.2d 732, 735, 93 USPQ 23, 26 (CCPA); *Ranco, Inc. v. Gwynn et al.*, 128 F.2d 437 (54 USPQ 3)). And, as the request system communicates with the data encryption/retrieval system an inherent or at least obvious means for sending data would be via a wireless network. The remote print system (figure 1) has an address as it resides on a network. Further, this address is "provided" to a user of the Choudhury et al. system as the user then uses the address for receiving messages to be printed

(abstract). Therefore, it would have been obvious to one of ordinary skill apply the encryption method disclosed by Maldy ('406, column 1, lines 5-47) to communications between a printer and a server in order to prevent illicit copying of confidential messages intended for printing ('406, column 1, lines 10-16; '074, column 1, lines 9-32 and column 2, lines 15-47; column 4, lines 31-42).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
- Ginter et al. teach a printer that generates cryptographic keys

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry and after-final communications),

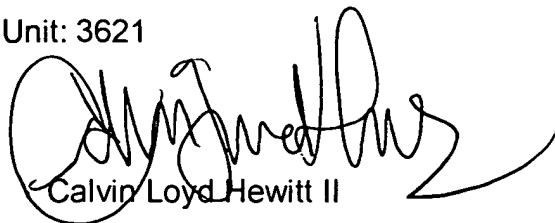
or:

(571) 273-6709 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

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A handwritten signature in black ink, appearing to read "Calvin Hewitt II", written over the printed name.

Calvin Loyd Hewitt II

January 4, 2006